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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,410	12/12/2000	Burkhard Goke	P03986US2	8826

7590 06/26/2003

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EXAMINER

MOHAMED, ABDEL A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 06/26/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,410

Applicant(s)

GOKE ET AL.

Examiner

Abdel A. Mohamed

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- For restriction/election purposes only.*
- 1) ☒ Responsive to communication(s) filed on 12 December 2000.

- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.

- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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ELECTION/RESTRICTION

1. Claims 1-9, drawn to a composition comprising a compound which binds to a receptor for "GLP-1", and a pharmaceutical carrier thereof, classified in class 530, subclasses 308 and 324, will be examined along with any elected groups.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 10-38, drawn to a method for treating an individual/human with impaired glucose tolerance by administering the composition comprising a compound which binds to a receptor for "GLP-1", and a pharmaceutical carrier thereof, classified in class 514, subclasses 12, 866 and 909.
 - II. Claim 39, drawn to a method for treating an individual whose symptoms indicate increased risk of a cardiovascular event by administering the composition comprising a compound which binds to a receptor for "GLP-1", and a pharmaceutical carrier thereof, classified in class 514, subclasses 12 and 854.
 - III. Claim 40, drawn to a method for treating an individual whose symptoms indicate increased risk of a cerebrovascular event by administering the composition comprising a compound which binds to a receptor for "GLP-1", and a pharmaceutical carrier thereof, classified in class 514, subclasses 12, 929 and 930.

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3. The inventions are distinct, each from the other because:

Although Inventions I-III are related, the etiology or cause for the aforementioned disease symptoms and/or entities are divergent and a search conducted for one would not necessarily overlap with a search conducted for another. Thus, Inventions I-III, are related as independent methods which are not connected in design, operation or effect. Although, the methods of Groups I-III use the same composition, however, the methods have different functions and different effects. The group require different patent and literature search and a reference teaching a method for treating impaired glucose tolerance will not teach a method for treating symptoms which indicate increased risk of a cardiovascular event nor a method for treating symptoms which indicate increased risk of a cerebrovascular event and *vice versa*. Thus, the methods of Groups I-III are independent and distinct inventions which differ in method of diagnosis and/or symptoms treatment steps, parameters and purposes used, and as such, one does not require the other for ultimate use and is capable of separate manufacture, use and sale, and is novel and patentable over each other.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the searches for individual subject groups are not coextensive, restriction for examination purposes as indicated is proper.

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5. A telephone call was made to Edmund J Sease on 6/19/03 to request an oral election to the above restriction requirement, but did not result in an election being made.
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

CONCLUSION AND FUTURE CORRESPONDENCE

8. Claims 1-40 are subject to election/restriction requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

MY Mohamed/AAM

June 13, 2003

Christopher S. F. Low

CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800